

REMARKS

Claims 1-14, 20-21 and 28-31 are pending in the Application and are now presented for examination. Claims 1 and 20 have been amended to address the 35 U.S. C. §101 rejection. No new matter has been added.

Claims 1, 20, 28, 29 and 30 are independent.

Claim Rejections – 35 U.S.C. §101

On page 2 of the Office Action, Claims 1-14, 20-21, 28-29 and 31 were rejected under 35 U.S.C. §101 because, according to the Office Action, the claimed invention is directed to non-statutory subject matter.

Independent Claim 1

Independent Claim 1, as amended, recites, in part, a “program controller *apparatus* arranged for use with a modular system . . . the controller *apparatus* being arranged to manage the program automatically, according to an agreement between a supplier and a customer, the agreement having terms stored within the program controller *apparatus*, and according to a stored history of use of the hardware module.” (emphasis added). The Office Action incorrectly states that Claim 1 (and Claims 2-14, 20-21, 28-29 and 31) are “software per se” and that the “claimed ‘structure’ of the invention is composed entirely of software” (Office Action, page 2, paragraph 4). The Office Action cites page 11, line 23 of the specification, which includes the language “the program controller being in the form of software”. However, the Examiner has ignored other portions of the specification that defines the program controller as an “apparatus” and not software.

Specifically, page 10 of the specification recites the following:

Another aspect provides the **apparatus** for managing a program for use with a replaceable hardware module of a modular system, the module being a customer-replaceable part, the **apparatus** having means for accessing a stored history of use of the hardware module, and means for managing the program automatically, according to the history and according to an agreement between a supplier and a customer. (emphasis added)

This portion of the specification clearly supports the “program controller” of Claim 1 as an apparatus, not software. To further clarify this, Applicants have amended Claim 1 to add the term “apparatus” after “program controller” to lend further support to Applicants’ argument that what is managing the program is *an apparatus*. Page 10 of the specification provides full support for this feature. Thus, the statement on Page 2 of the Office Action that “the claimed ‘structure’ of the invention is composed entirely of software (e.g. controller, interface) and as such is non-statutory” is incorrect.

Applicants also note that Claim 1 recites that there are “terms **stored within** the program controller apparatus” (emphasis added). The fact that the program controller apparatus can “store” data itself shows that the controller is clearly tied to a tangible device, in this case a tangible computing device.

For at least these reasons, Claim 1, as amended, recites statutory subject matter, and the rejection related to this claim under 35 U.S.C. § 101 should be withdrawn.

Independent Claim 20

Independent Claim 20, as amended, recites, in part, a modular system with one or more *hardware* modules, and a program controller, arranged for use with the modular system . . . the controller being arranged to manage the program automatically . . .” (emphasis added). Claim 20, like Claim 1, is an apparatus claim, and not software, and is fully supported by the specification. As an example, the modular system includes tangible “hardware modules”. Also,

Claim 21 further recites that the system of Claim 20 includes “an interface for coupling.” Here again, such an element not only shows that Claim 21 is directed toward a tangible element, but also shows that Claim 20 is a tangible device by virtue of its interconnection with and inclusion of the an “interface.” For at least these reasons, Claim 20, as amended, and Claim 21 recite statutory subject matter, and the rejection related to these claims under 35 U.S.C. § 101 should be withdrawn.

Independent Claim 28

Independent Claim 28 recites, in part, a “method *performed by a program controller apparatus* of managing a program *that operates upon a replaceable hardware module of a modular system*, the module being a customer-replaceable part . . .” (emphasis added). The process recited in Claim 28 qualifies as statutory subject matter under 35 U.S.C. § 101 since it is tied to an apparatus, namely, a replaceable hardware module. Further, the tie to this apparatus *does not represent extra-solution activity* because the process can result in the detection or preemption of the coupling of an incompatible module (as described in the specification at least on Page 4, lines 31-32). Clearly, this relationship to the hardware module does not represent extra-solution activity, but an important factor in the claimed process.

Further, the Office Action indicates that to accomplish the requirement of positively reciting the other statutory class to which the method is tied, the claim “should positively recite the machine that accomplishes the method steps.” (Office Action, Page 3, paragraph 9). Claim 28 positively states that the method is “performed *by a program controller apparatus*”. For at least these reasons, Claim 28 recites a method that qualifies as statutory subject matter, and the rejection related to this claim under 35 U.S.C. § 101 should be withdrawn.

Independent Claim 29

Independent Claim 29, as amended, recites, in part, an “*apparatus* for managing a program for use with a replaceable hardware module of a modular system . . .” (emphasis added). As discussed above, Claim 29 is an apparatus claim that recites an apparatus that manages a program for use with a replaceable hardware module of a modular system and includes a “means for accessing a stored history of use”. The support for the apparatus that performs the recited functions is disclosed at least on page 10 of Applicants’ specification. It is noted that such a “means for accessing” can be a program controller apparatus (discussed above), which itself is a tangible apparatus (see paragraph [00189]). Claim 29 is an apparatus claim that clearly qualifies as statutory subject matter. Therefore, the rejection related to this claim under 35 U.S.C. § 101 should be withdrawn.

Dependent Claims 2-14, 21 and 31

Claims 2-14, 21 and 31, are each dependent either directly or indirectly from one or another of independent Claim 1 or Claim 20, discussed above. These claims recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claims are therefore believed patentable. However, the individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

Claim Rejections – 35 U.S.C. §102

On page 4 of the Office Action, Claims 1-14, 20-21, 29-30 were rejected under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent No. 5,926,624 to Katz *et al.* (“Katz”).

Applicants respectfully disagree with this rejection.

Independent Claim 1

Independent Claim 1, as amended, recites a program controller apparatus “arranged for use with a modular system”. The controller apparatus is arranged to manage the program automatically, “*according to an agreement between a supplier and a customer, the agreement having terms stored within the program controller apparatus, and according to a stored history of use of the hardware module.*” Katz does not teach or suggest these features. In fact, the Office Action admits this. Page 5 of the Office Action (under the 35 U.S.C. §103 section) clearly states that Katz “does not specifically disclose ‘the controller being arranged to manage the program automatically according to an agreement between a supplier and a customer, the agreement having terms stored within the program controller apparatus, and according to a stored history of use of the hardware module.’”

There is no disclosure whatsoever in Katz describing or suggesting a program controller that automatically manages a program “according to an agreement between a supplier and a customer” and “*according to a stored history of use of the hardware module.*” The system in Katz does not operate based on the terms of any agreement between a supplier and a customer. The storage of client identifiers, client billing history, player usage history and other client personal information does not equate to a program controller that operates based upon an *agreement* between the customer and the supplier.

Further, Katz fails to disclose or suggest a program controller that is arranged to “manage a program for use with a replaceable hardware module of a modular system.” The apparatus in Katz is directed toward a digital information library having encryption protocols for securing the transfer of digital information library programs to a client’s computer system and to a mobile digital information playback device. Katz discloses the use, by the client’s computer system, of logic for requesting downloads of selected digital files from the library server, and discloses logic for downloading the selected file to the mobile device. The Office Action (page 5, paragraph 14) vaguely refers to Column 11, lines 1-31 as disclosing the program controller. Yet this passage fails to identify, *specifically*, what the program controller is. Instead, it merely refers to the various components of the library server and the client computer system, none of which constitute the program controller apparatus as recited in Claim 1. In fact, nowhere in the Katz reference is there any disclosure of a program controller adapted to perform the functions recited in Claim 1.

Thus, because Katz fails to disclose the features discussed above, (the lack of disclosure in Katz clearly supported by the Office Action), Katz does not teach each of the features of amended Claim 1. Consequently, the rejection of Claim 1 under 35 U.S.C. §102 should be withdrawn.

Independent Claim 20

Independent Claim 20 recites features similar to the features of Claim 1, discussed above. Specifically, Claim 20 recites a “program controller. . . arranged to manage a program for use with a replaceable hardware module of the modular system . . . according to an agreement

between a supplier and a customer, and according to a stored history of use of the hardware module.” As discussed above, Katz fails to disclose or suggest these features.

For at least these reasons, the rejection of Claim 20 under 35 U.S.C. §102 should be withdrawn.

Independent Claim 29

Independent Claim 29 recites features very similar to those recited in Claim 20, discussed above. Claim 29 recites an apparatus for managing a program for use with a replaceable hardware module of a modular system, the apparatus having means for accessing a stored history of use of the hardware module, and means for managing the program automatically, *according to the history and according to an agreement between a supplier and a customer.* (emphasis added). As discussed above with respect to Claims 1 and 20, Katz does not teach or suggest these features. Therefore, the rejection of Claim 29 under 35 U.S.C. §102 should be withdrawn.

Independent Claim 30

Independent Claim 30 recites computer program that performs the steps of accessing a stored history of use of the hardware module, and controlling the program automatically, *according to the history and according to an agreement between a supplier and a customer.* As discussed above, Katz does not disclose or suggest these features. For at least this reason, the rejection of Claim 30 under 35 U.S.C. §102 should be withdrawn.

Dependent Claims 2-14 and 21

Claims 2-14 and 21 are each dependent either directly or indirectly from one or another of independent Claims 1 or 20, discussed above. These claims recite additional limitations which, in conformity with the features of their corresponding independent claim, are not

disclosed or suggested by the art of record. The dependent claims are therefore believed patentable. However, the individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

Claim Rejections – 35 U.S.C. §103

On page 5 of the Office Action, Claims 1-14, 20-21 and 28-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Katz in view of U.S. Patent No. 5,499,298 to Narasimahalu. Applicants respectfully disagree with this rejection.

Independent Claim 1

As discussed above, Katz fails to disclose a program controller that is arranged to “manage a program for use with a replaceable hardware module of a modular system” and that is arranged to manage the program automatically, “*according to an agreement between a supplier and a customer, the agreement having terms stored within the program controller apparatus, and according to a stored history of use of the hardware module.*” The Office Action cites Narasimahalu in the 35 U.S.C. §103(a) rejection, stating that Narasimahalu discloses a controller “arranged to manage a program automatically according to an agreement between a supplier and a customer, the agreement having terms stored within the program controller and according to a stored history of use of the hardware module.” However, Narasimahalu does not disclose these features.

Narasimahalu relates to a method for controlling the dissemination of digital information. An end user accesses digital information with a tamper-proof controlled information access device by decrypting the digital information. A controller disposed in the controlled information

access device permits end users to access transparently uncontrolled information. Controlled digital information will be accessed as long as the conditions specified by the information provider are met. Narasimahalu makes no mention whatsoever of any agreement between the supplier and the customer that is stored the “within the program controller.” Nor does Narasimahalu disclose a controller being arranged to manage a program automatically “according to a stored history of use of the hardware module.”

The Office Action refers to the following passage as allegedly disclosing the claimed elements absent in Katz:

The objective of the on-line scheme of controlled dissemination of digital information is to achieve improved control of the delivery of information so that once the information is accessed by the information consumer for a specified number of times, the information no longer exists in a usable form without authorization from the information provider. The enhanced control of information dissemination is achieved by using encryption and by limiting an information consumer's access at a designated legal access device during an access window.

Narasimahalu, col. 8, line 64-col. 9, line 6.

The above passage relates only to a relationship between the information supplier and user to limit the number of times certain provider information can be accessed by the user. Narasimahalu fails to disclose an agreement or contract between the supplier and customer that is stored “within the program controller.” The Office Action cites col. 10, lines 25-31 of Narasimahalu (“[a]fter verifying the information consumer's request in step 174 of FIG. 10, the Information Provider 10 generates an Opener as outlined in steps 160-166 of FIG. 9 and transmits the Opener to the information consumer in step 174 of FIG. 10. The information consumer presents the Sealed-COIN received earlier and the Opener to Controller 48 for accessing the COIN in step 176”) as allegedly supplying this

feature. However, this passage does not disclose the location of an agreement between the information supplier and the customer. Nor does any other passage in Narasimahalu. Thus, Narasimahalu fails to teach “an agreement between a supplier and a customer, the agreement having terms stored within the program controller.”

Narasimahalu also fails to disclose a controller arranged to manage a program automatically “according to a stored history of use of the hardware module.” The Office Action cites col. 9, lines 25-26 of Narasimahalu (“LAD The device on which the COIN can be accessed legally”) as allegedly disclosing this feature. It does not. Further, any contract or agreement between the supplier and the customer in Narasimahalu provides “at a minimum that the information provider shall provide some [original information encoded in some digital form] to the information consumer for a total number of legal accesses on certain [devices upon which the information can be accessed legally] (Narasimahalu, col. 9, lines 37-41). Narasimahalu does not create an agreement between the information supplier and the customer based upon any “stored history of use of the hardware module”, as is claimed.

In sum, neither Katz or Narasimahalu, whether taken alone or in combination, discloses a “program controller apparatus arranged for use with a modular system, and arranged to manage a program for use with a replaceable hardware module of the modular system . . . the controller apparatus being arranged to manage the program automatically, according to an agreement between a supplier and a customer, the agreement having terms stored within the program controller apparatus, and according to a stored history of use of the hardware module”, as recited in amended Claim 1.

Applicants therefore respectfully request the withdrawal of the rejection of Claim 1 under 35 U.S.C. §103.

Independent Claim 20

Independent Claim 20 recites features similar to those of Claim 1, discussed above. Specifically, Claim 20 recites a modular system having a program controller “arranged to manage a program for use with a replaceable hardware module of the modular system”, and “arranged to manage the program automatically, according to an agreement between a supplier and a customer, and according to a stored history of use of the hardware module.” As discussed above, the Office Action admits that Katz does not disclose a controller automatically managing a program according to an agreement between the supplier and the customer. As also discussed above, Narasimahalu fails to disclose a program controller arranged to manage a program “according to a stored history of use of the hardware module.” Thus, even if somehow combined, Katz and Narasimahalu fail to disclose or suggest each and every element of Claim 20. Applicants therefore respectfully request the withdrawal of the rejection of Claim 20 under 35 U.S.C. §103.

Independent Claim 28

Independent Claim 28 recites a method performed by a program controller apparatus of managing a program that operates upon a replaceable hardware module of a modular system, the module being a customer-replaceable part. The method includes “accessing a stored history of use of the hardware module, and controlling the program automatically, according to the history and according to an agreement between a supplier

and a customer.” As discussed above, the Office Action admits that Katz does not disclose a controller automatically managing a program according to an agreement between the supplier and the customer. As also discussed above, Narasimahalu fails to disclose a program controller that manages a program that operates “upon a replaceable hardware module of a modular system according to the history [of use of the hardware module].” Thus, even if somehow combined, Katz and Narasimahalu, fail to disclose or suggest each and every element of Claim 28. Applicants therefore respectfully request the withdrawal of the rejection of Claim 28 under 35 U.S.C. §103.

Independent Claim 29

Independent Claim 29 recites virtually identical features to the features of Claim 28, discussed above. For at least the same reasons discussed above, Katz or Narasimahalu, whether taken alone or in combination, fail to disclose or suggest each of the elements recited in Claim 29. Applicants therefore respectfully request the withdrawal of the rejection of Claim 29 under 35 U.S.C. §103.

Independent Claim 30

Independent Claim 30 recites virtually identical features to the features of Claim 28 and Claim 29, discussed above. For at least the same reasons discussed above, Katz or Narasimahalu, whether taken alone or in combination, fail to disclose or suggest each of the elements recited in Claim 30. Applicants therefore respectfully request the withdrawal of the rejection of Claim 30 under 35 U.S.C. §103.

Dependent Claims 2-13, 21 and 31

Applicants respectfully point out that although Claims 32 and 33 were listed as being rejected under 35 U.S.C. §103, Claims 32 and 33 were previously canceled.

Claims 2-13, 21 and 31, are each dependent either directly or indirectly from one or another of independent Claims 1 or 20, discussed above. These claims recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claims are therefore believed patentable. However, the individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

For all of the above reasons, the claim objections are believed to have been overcome placing Claims 1-14, 20-21 and 28-31 in condition for allowance, and reconsideration and allowance thereof is respectfully requested.

The Examiner is encouraged to telephone the undersigned to discuss any matter that would expedite allowance of the present application.

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The Commissioner is hereby authorized to credit overpayments or charge payment of any additional fees associated with this communication to Deposit Account No. 502104.

Respectfully submitted,

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